

## **REMARKS**

No claims have been amended or canceled or added. Hence claims 31 – 44 are pending examination.

Claims 31 – 44 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 31 – 44 are rejected under 35 USC 102(e) as being anticipated by U.S. Patent No. 6,668,295, herein Chan.

### **Rejections Under 35 USC 112**

Claims 31 - 44 are rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner states that the rejection stems from several alleged defects in claims 31 and 38. At least several of the defects seem to be addressed to the term “resource”.

The first alleged defect is that Applicant fails to define the metes and bounds of the "a first resource" and "a second resource". Presumably, the Examiner is stating that the disclosure does not provide a definition for the term "resource" and therefore claims 31 and 38 are indefinite. For the purposes of argument, assuming as a fact that such a definition is absent from the disclosure, such a fact is not enough to render claims 31 and 38 indefinite under 35 USC 112, second paragraph.

MPEP 2106 (III) (C) states that "Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well known in the art, the applicant does not have to provide a disclosure that describes those elements. In such a case the elements will be construed as encompassing any and

every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities."

The above passage from the MPEP sets forth the effect for construing elements not defined in the disclosure. The effect is that if the elements are well known in the art, then the elements are to be construed in the art recognized way. (MPEP 2106(III)(A)) The effect is not to find them indefinite, under 35 USC 112, second paragraph.

A "resource" for which a lock may be requested, as claimed, has an ordinary and customary meaning to those of ordinary skill, and is therefore well known in the art. Thus, the examiner should construe "resource" in the art recognized way, and not reject the term as indefinite under 35 USC 112.

The second defect regards requiring "a second resource different than said first resource". Since "resource" is well known, and the word "different" is well known, the Examiner should construe these terms in the art recognized way, and not reject the terms as indefinite under 35 USC 112, second paragraph.

The third alleged defect is that "the claims extensively use the phrase "wherein", but the specification fails to provide actual steps to perform or limit these claims to a particular structure, thus, this term renders the claimed scope to be indistinct." Assuming, for purposes of argument, that the specification does fail to provide actual steps to perform or limit terms of claims 31 and 38 to a particular structure, such a finding does not render a claim invalid under 35 USC 112, second paragraph, even with regard to limitations based on "wherein" clauses.

In support of this rejection, the Office Action cites *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996). This citation is found in a section of the MPEP regarding analyzing a claim's scope. (see, 2106(II)(C)). In this section, the MPEP states the

following about assessing claim language scope, including the scope of "wherein" clauses.

**The subject matter of a properly construed claim is defined by the terms that limit its scope.** It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) **"wherein"** clauses, or
- (D) "whereby" clauses.

...Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996). Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunracer Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (**"In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."**) However, an applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning. *See In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) >and *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996)<.

The above section of the MPEP sets forth the rules for interpreting claim language to assess claim scope, including the language of wherein clauses. The section highlights the general principle that claim interpretation "must rely on the applicant's disclosure to properly determine the meaning of the claims." The MPEP then further qualifies this

principle by stating "the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art," "unless that meaning is rebutted by clearly setting forth a definition of the term that is different from its ordinary and customary meaning."

Thus, the MPEP states that for the purpose of analyzing claim scope, the specification is used to rebut any ordinary meaning of claim language. The MPEP does not, however, require that the specification provide an explicit definition, step, or structure for the claim language in order for the claim's language to be definite under 35 USC 112, particularly, if the claim language has meaning attributed to it by those of ordinary skill in the art. Therefore, the Office Action's basis for rejecting claims 31 and 38 under 35 USC 112, second paragraph, that the specification fails to provide actual steps to perform or limit these claims to a particular structure, even if true, is not a valid basis for rejecting claims 31 and 38 under 35 USC 112, second paragraph. Removal of these rejections is respectfully requested.

### **Rejections Based on Prior Art**

#### **Claims 31 and 38**

Claims 31 and 38 recite:

[a] response that denies said request for a certain lock on said first resource is caused by a blocking condition;  
... determining said blocking condition is no longer in effect by performing certain steps that include:  
said requester transmitting to said lock management system a request for a lock on said second resource; and  
said requester receiving from said lock management system a response that grants said request for said lock on said second resource.

The cited art clearly fails to describe the claimed steps for determining that a blocking condition is no longer in effect for a resource, which include, requesting a lock on another resource and receiving a response that grants the request for the lock on the other resource.

The Office Action, however, cites various passages (i.e. col. 3, lines 47 – 57, lines 60 – 67, col. 4, lines 1 – 18) of Chan as disclosing these steps. None of these passages disclose or suggest in any way determining that a blocking condition is in effect using the particular steps claimed.

In these passages, Chan describes a requesting process requesting to convert to a shared lock on a resource. The request is not granted because an exclusive lock has been granted for this resource. The grant of the exclusive lock can be analogized to a blocking condition. When the blocking condition is no longer in effect, i.e., the exclusive lock is relinquished, the request for the shared lock is granted, and a message is sent to the requesting process to inform it that the shared lock requested is granted.

Assuming these steps may be equated to a way for determining when a blocking condition for a resource is in effect, at best the passages teach that such a determination for the resource is made by requesting a lock on the same resource and being informed by a message of when the lock has been granted on the same resource. Claims 31 and 38, on the other hand, teach that such determination is made by making a request for a lock on a different resource, not the same resource, and by receiving a response that grants the request for the lock on the other resource.

Based on the foregoing, claims 31 and 38 are patentable over the cited art under 35 USC 102. Reconsideration and allowance of claims 31 and 38 are respectfully requested.

**Remaining Pending Claims**

The pending claims not discussed so far are dependant claims that depend on an independent claim that is discussed above. Because each of the dependant claims include the limitations of claims upon which they depend, the dependant claims are patentable for at least those reasons the claims upon which the dependant claims depend are patentable. Removal of the rejections with respect to the dependant claims and allowance of the dependant claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. Due to the fundamental difference already identified, a separate discussion of those limitations is not included at this time.

For the reasons set forth above, Applicant respectfully submits that all pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Respectfully submitted,

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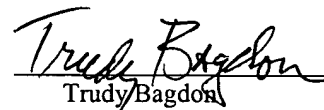
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on July 17, 2006

by

  
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